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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,224	12/09/2003	Neil P. Desai	225602	4904

23460 7590 11/24/2004

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EXAMINER

TSAY, MARSHA M

ART UNIT PAPER NUMBER

1653

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,224

Applicant(s)

DESAI ET AL.

Examiner

Marsha M. Tsay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-93 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claims 1-93 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, 77-84, 91-93, drawn to a pharmaceutical composition comprising a pharmaceutical agent and a pharmaceutically acceptable carrier, classified in class 514, subclass 12.
- II. Claims 19-36, drawn to a method for reducing one or more side effects associated with administration of a pharmaceutical composition to a human, classified in class 514, subclass 922.
- III. Claims 37-43, drawn to a method for inhibiting microbial growth in a pharmaceutical composition, classified in class 530, subclass 402.
- IV. Claims 44-50, drawn to a method for inhibiting oxidation of a pharmaceutical composition, classified in class 530, subclass 402.
- V. Claims 51-63, drawn to a method for enhancing transport of a pharmaceutical agent to the site of an infirmity, classified in class 514, subclass 44.
- VI. Claims 64-76, drawn to a method for enhancing binding of a pharmaceutical agent to a cell in vitro or in vivo, classified in class 514, subclass 44.

- VII. Claims 85-90, drawn to a method for increasing the transport of a pharmaceutical agent to a cell in vitro or in vivo, classified in class 424, subclass 198.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-VII are related as product and process(es) of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the pharmaceutical composition of Invention I can be used.

Inventions II-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are all different methods of using a pharmaceutical composition. The methods all have different functions and thus serve distinct purposes. Invention II is drawn to a method for reducing one or more side effects in a human, which is patentably distinct from Invention III, drawn to a method for inhibiting microbial growth in a pharmaceutical composition. Invention IV is drawn to a method for inhibiting oxidation of a pharmaceutical composition, which is different than Inventions II-III. Invention V is drawn to a method for enhancing transport of a pharmaceutical agent to the site of an infirmity and is patentably distinct from Inventions II-IV. Invention VI is drawn to a method for enhancing binding of a pharmaceutical

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agent to a cell *in vitro* or *in vivo*, which is functionally different than Claims II-V.

Invention VII is drawn to a method for increasing the transport of a pharmaceutical agent to a cell *in vitro* or *in vivo*, which is patentably distinct from Inventions II-VI.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

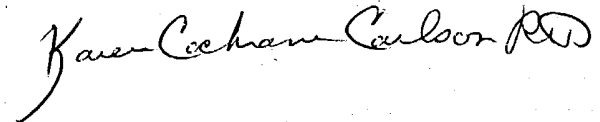
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marsha M. Tsay whose telephone number is 571-272-2938. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 22, 2004

A handwritten signature in cursive script that reads "Karen Cochrane Carlson" followed by a stylized monogram or initials.

KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER